

### **REMARKS/ARGUMENTS**

Applicants have reviewed and analyzed the Office Action dated July 18, 2008, and provide the following remarks and comments in response thereto. Claims 1-10, 26, 37 and 38 have been amended. No new matter has been added. Claims 1-19, 26-34, 37 and 38 are pending upon entry of the present amendment.

#### ***Claim Rejections Under 35 U.S.C. §101***

Claims 26-34 stand rejected under 35 U.S.C. §101 for allegedly being directed to non-statutory subject matter. In particular, the Office Action notes that the Specification, at p. 8, describes computer readable media as encompassing statutory media such as ROM, hard drives, optical drives as well as non-statutory subject matter such as a signal. Without addressing the validity of this assertion, Applicants have amended the claims to recite a tangible computer readable storage medium which does not include intangible media such as signals. Accordingly, Applicants traverse this rejection.

#### ***Claim Rejections Under 35 U.S.C. §102***

Claims 1-6, 9-16 and 18 stand rejected under 35 U.S.C. §103(a) as being unpatentable by Reynolds *et al.* (U.S. Patent Pub. No. 2001/0037500, “Reynolds”) in view of Gordon *et al.* (U.S. Patent Pub. No. 2001/0014975, “Gordon”) and Zigmond *et al.* (U.S. Patent No. 6,698,020, “Zigmond”). This rejection is respectfully traversed.

Amended independent claim 1 recites, *inter alia*, a set-top box having memory storing instructions that, when executed, cause the set-top box to receive media separate from a broadcast stream, the media having a second priority indicator greater than a first priority indicator of the broadcast stream, receive a signal configured to modify the first priority indicator from a first priority to a second priority, and modify the first priority indicator from the first priority to the second priority in response to receiving the signal. The Office Action concedes that Reynolds does not explicitly disclose receiving a signal configured to modify the first priority indicator from a first priority to a second priority. The Office Action instead relies upon Gordon to allegedly describe such a feature. Specifically, the Office Action at pp. 5-6 asserts that Gordon discloses receiving a signal (e.g., control signal) configured to modify the first

priority indicator (e.g., priorities of the viewable data objects) from a first priority to a second priority and modifying the priority indicator in response to receiving the signal at para. [0029]. Applicants respectfully disagree. The cited passage of Gordon merely states that priorities may be fixed or dynamical and that dynamical priorities may change in response to a control signal from a network manager. Significantly, nowhere does Gordon teach or suggest that the priorities are changed by and in response to a signal received at the set-top box. In fact, Gordon describes that it is the local servers, not set-top boxes, that have intelligence to resolve conflicts and to assign different priorities as necessary. p. 4, paras. [0063]-[0065]. Gordon further states that the manager 39 transmits new priority ratings to local servers 43-49, not set top boxes. p. 5, para. [0073]. Accordingly, claim 1 is allowable for at least these reasons.

Independent claim 11 recite features similar to those discussed with respect to claim 1 and is thus allowable for at least the same reasons as claim 1 and further in view of the novel and non-obvious features recited therein.

Claims 2-6, 9, 10, 12-16 and 18 are dependent on claims 1 and 11, respectively, and are thus allowable for at least the same reasons as their base independent claim.

Claims 26-31, 33 and 34 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Reynolds in view of Gordon.

Amended independent claim 26 recites features similar to those discussed above with respect to claim 1 and is thus allowable over Reynolds and Gordon for at least the same reasons as claim 1. Claims 27-31, 33 and 34 are dependent on claim 26 and are thus allowable for at least the same reasons as claim 1.

Claims 7, 19 and 37 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Reynolds in view of Gordon, Zigmond and Blackketter *et al.* (U.S. Patent Pub. No. 2002/0056129, "Blackketter").

Claims 7, 19 and 37 are dependent on claims 1, 11 and 26, respectively. Blackketter does not cure the deficiencies identified above with respect to claims 1, 11 and 26. Accordingly and notwithstanding whether the asserted combination is valid, claims 1, 11 and 26 are allowable over Reynolds, Gordon, Zigmond and Blackketter. Claims 7, 19 and 37 are also allowable for at least the same reasons as claims 1, 11 and 26.

Claims 8, 17 and 32 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Reynolds in view of Gordon, Zigmond and Bullock *et al.* (U.S. Patent No. 5,070,404, “Bullock”). Applicants respectfully traverse this rejection for at least the following reasons.

Claims 8, 17 and 32 are dependent on claims 1, 11 and 26, respectively. Bullock does not cure the deficiencies identified above with respect to claims 1, 11 and 26. Accordingly and notwithstanding whether the asserted combination is valid, claims 1, 11 and 26 are allowable over Reynolds, Gordon, Zigmond and Bullock. Claims 8, 17 and 32 are also allowable for at least the same reasons as claims 1, 11 and 26.

Claim 32 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Reynolds in view of Gordon and Bullock.

Claim 32 is dependent on claim 26 and thus includes all of the features of claim 26. Bullock does not cure the deficiencies identified above with respect to claim 26. Accordingly and notwithstanding whether the asserted combination is valid, claim 26 is allowable over Reynolds, Gordon and Bullock. Claim 32 is also allowable for at least the same reasons as claim 26.

Claim 38 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Reynolds in view of Gordon, Zigmond and Robinett *et al.* (U.S. Patent No. 6,351,474, “Robinett”).

Claim 38 is dependent on claim 26 and thus includes all of the features of claim 26. Robinett does not cure the deficiencies identified above with respect to claim 26. Accordingly and notwithstanding whether the asserted combination is valid, claim 26 is allowable over Reynolds, Gordon and Robinett. Claim 38 is also allowable for at least the same reasons as claim 26 and further in view of the novel and non-obvious features recited therein. For example, claim 38 recites, *inter alia*, “determine that the first priority indicator is greater than the second priority indicator prior to receiving the signal; and delaying the insertion of the separate media into the broadcast stream until the first priority indicator is modified.” Contrary to the Office Action’s assertions at p. 14, Robinett does not teach or suggest such features. The Office Action appears to analogize the delay of the insertion of the separate media into a broadcast stream until the first priority indicator is modified to delaying an insertion of a changed PID mapping until a new/modified version of the PMT or CAT is available. Even assuming that Robinett describes

delaying the insertion of a changed PID mapping, Applicants respectfully disagree with such an analogy. Specifically, a PID (i.e., packet identifier) mapping does not constitute separate media that is inserted into a broadcast stream. Additionally, nowhere does Robinett teach or suggest that the insertion of the separate media is delayed until the first priority indicator is modified. Not only does the PMT or CAT fail to describe a priority indicator, Robinett does not teach or suggest that insertion is delayed until the PMT or CAT is modified. Instead, Robinett states that any changes to PID mapping are preferably delayed until a new version of the PMT can be *outputted* in the TS. Outputting does not constitute modifying. Accordingly, claim 38 is allowable for this additional reason.

### **CONCLUSION**

All rejections having been addressed, Applicants respectfully submit that the instant application is in condition for allowance, and respectfully solicit prompt notification of the same. However, if for any reason the Examiner believes the application is not in condition for allowance or there are any questions, the Examiner is requested to contact the undersigned at (202) 824-3156.

Respectfully submitted,

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